

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Art Unit: 1624

BOLLBUCK et al.

Examiner: E. O. Sackey

APPLICATION NO: 10/532,331

FILED: April 22, 2005

FOR: 1-(4-BENZYL-PIPERAZIN-1-YL)-3-PHENYL-PROPENONE
DERIVATIVES

MS: General
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PETITION REGARDING PATENT TERM ADJUSTMENT UNDER C.F.R. §1.705(b)

Sir:

In accordance with 37 C.F.R. § 1.705(b), Applicant hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 948 days. This application is being filed with the payment of the issue fee, as required by 37 C.F.R. § 1.705 (b).

I. Fee/

As required by 37 C.F.R. § 1.705(b)(1), this application is accompanied by a request to charge Deposit Account No. **50-4409** for \$ 200.00 to cover the required fee (as defined in 37 C.F.R. § 1.18(e)). Please charge any deficiencies or any additional fees due in response to this request to Deposit Account **50-4409**.

II. Statement of the Facts Involved

A. Correct Patent Term Adjustment

The Notice of Allowance, which was mailed on May 29, 2009, indicated a preliminary Patent Term Adjustment of 629 days.

Patentee has calculated an initial patent term adjustment of 948 days based on the following facts:

Case Law

In *Wyeth v. Dudas*, 2008 U.S. Dist. LEXIS 76063 (D.D.C. 2008), the District Court of the District of Columbia addressed the United States Patent and Trademark Office (USPTO) interpretation of 35 U.S.C. § 154(b)(2). The Court granted summary judgment in favor of Wyeth, determining that the USPTO misconstrued the first sentence of 35 U.S.C. § 154(b)(2)(A), and as a result, improperly denied Wyeth a portion of patent term to which Wyeth was entitled under 35 U.S.C. § 154.

In the opinion, the Court stated that "the PTO's view is that any administrative delay under § 154(b)(1)(A) overlaps any 3-year maximum pendency delay under § 154(b)(1)(B): the applicant gets credit for 'A delay' or for 'B delay,' whichever is larger, but never A + B." However, Plaintiff Wyeth argued that the § 154(b)(1)(A) and § 154(b)(1)(B) period overlap only if they occur on the same calendar day or days. The Court determined that Wyeth's construction of § 154(b)(2)(B) was correct.

Simply put, the holding of the Court is that the excluded overlap recited in the first sentence of 35 U.S.C. § 154(b)(2)(A) only occurs if a 35 U.S.C. § 154(b)(2)(A) period and a 35 U.S.C. § 154(b)(2)(B) period run concurrently. As such, a patent holder is entitled to recoup the 35 U.S.C. § 154(b)(2)(A) period that falls outside of the 35 U.S.C. § 154(b)(2)(B) period in addition to the 35 U.S.C. § 154(b)(2)(B) period itself.

Relevant Dates

The above identified application has a 35 U.S.C. §371 filing date of April 22, 2005.

The first Office Action was mailed on March 24, 2008, resulting in a PTO delay of 641 days beyond the 14 months provided by 35 U.S.C. §154(b).

A Response by Applicant was filed July 3, 2008, which was nine (9) days after the expiry of the 3 months provided by 35 U.S.C. §154(b) resulting in an Applicant delay of 9 days.

A Final Office Action was mailed October 14, 2008, within the 4 months provided by 35 U.S.C. §154(b).

A Response by Applicant and Notice of Appeal were filed January 8, 2009, within the 3 months provided by 35 U.S.C. §154(b).

An Advisory Action was mailed February 9, 2009, within the 4 months provided by 35 U.S.C. §154(b).

A Request for Continued Examination by Applicant was filed March 6, 2009, within the 3 months provided by 35 U.S.C. §154(b).

A Preliminary Amendment by Applicant was filed May 18, 2009 responsive to a request by the Examiner during a telephonic interview occurring on the same date.

A Notice of Allowance was mailed May 29, 2009, within the 4 months provided by 35 U.S.C. §154(b).

The issue fee has been paid on August 28, 2009 in a paper accompanying the instant petition, within the 3 months provided by 35 U.S.C. §154(b).

Accordingly, the initial PTO adjustment based on delay under 35 U.S.C. § 154(b)(2)(A) is 641 days. The reduction in term adjustment due to applicant delay is 9 days, resulting in a patent term adjustment of 632 days under 35 U.S.C. § 154(b)(2)(A).

The initial 35 U.S.C. § 154(b)(2)(B) period for the instant application began on April 22, 2008 (three years after the filing date of April 22, 2005) and ended on March 6, 2009, e.g., the filing date of the Request for Continued Examination. The initial 35 U.S.C. § 154(b)(2)(B) period running from April 22, 2008 until filing of the Request for Continued Examination (March 6, 2009) is 318 days. The reduction in term adjustment due to applicant delay is 0 days, resulting in an initial patent term adjustment of 318 days under 35 U.S.C. § 154(b)(2)(B).

There was 2 days of PTO delay under 35 U.S.C. § 154(b)(2)(A) that occurred within the initial 35 U.S.C. § 154(b)(2)(B) period that should be excluded from the patent term adjustment calculation under the holding of *Wyeth v. Dudas*. Thus the non-overlapping PTO delay under 35 U.S.C. §154(b)(2)(B) is 316 days.

Accordingly, the sum of the non-overlapping 35 U.S.C. § 154(b)(2)(B) delay (316 days) and non-overlapping 35 U.S.C. § 154(b)(2)(A) delay (632 days) is 948 days.

The initial PTA printed on the Notice of Allowance is only 629 days, which the USPTO is presumed to have calculated using the method considered proper before the holding of *Wyeth v. Dudas*. Applicants therefore respectfully request reconsideration of the initial PTA calculation.

B. Terminal Disclaimer

The above-identified patent is not subject to a Terminal Disclaimer.

C. Reasonable Efforts

Any applicant delays under 37 C.F.R. § 1.704 are set forth above. There were no other circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704.

Respectfully submitted,

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